

Application No. 10/823,203
Amdt. dated October 4, 2004
Reply to Office Action of September 9, 2004

054030-0056

REMARKS/ARGUMENTS

Following entry of the present paper, claims 3-11 remain pending in this application and claims 1-2 are withdrawn. Applicant reserves the right to pursue the withdrawn subject matter of claims 1-2 (i.e., Group I) in one or more divisional applications.

RESTRICTION REQUIREMENT AND APPLICANT'S ELECTION

In response to the Office Action mailed September 9, 2004, applicant elects for further prosecution the isolated and purified nucleic acids of Group II, as recited in claims 3-11, but respectfully traverses the restriction requirement and requests reconsideration of the same.

Applicant submits that the inventions of Group I and II are not proper for restriction under 35 U.S.C. § 121. The Examiner states that the isolated and purified nucleic acids of Group II are distinct from the isolated and purified proteins of Group I. In order to make a proper restriction, the Examiner must further provide an explanation supporting the conclusion that the search and examination of the entire application can not be made without serious burden on the Examiner. Applicant does not believe a serious burden has been *prima facie* established in this case. According to MPEP § 803, if search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, *even though it includes claims to independent or distinct inventions*. It is respectfully suggested that, upon careful consideration, the examination of Groups I and II can be made without serious burden to

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the Examiner even though such examination may include claims to independent or distinct inventions.

To rebut the prima facie showing of a serious burden, the Examiner is asked to consider the relatedness between the nucleic acids of Group II and corresponding proteins of Group I, which the respective nucleic acids encode. Based on the relationship between the polypeptides and nucleic acids, as claimed, applicant believes that search and examination of Groups I and II should be substantially co-extensive. In view of the inherent characteristics of the claimed subjects, one would not find it necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists. Therefore, no serious burden should be imposed on the Examiner. Accordingly, restriction in this instance appears improper and re-consideration is respectfully requested.

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CONCLUSION

In view of the election and arguments presented herein, applicant respectfully requests re-consideration of the restriction requirement and examination of at least the elected invention on the merits. Applicant requests that the Examiner telephone the undersigned in the event a telephone discussion would be helpful in advancing the prosecution of the present application. The Director is authorized to charge any additional fees or underpayment of fees regarding this response, including extensions for reply, to Deposit Account 07-1509.

Respectfully submitted,

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Dated: Oct. 4, 2004By: 

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